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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/995,151

11/27/2001

Steven L. Rohall

260-137

9916

44185

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03/05/2010

LOTUS AND RATIONAL SOFTWARE

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

03/05/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dave@davedagg.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/995,151	<b>Applicant(s)</b> ROHALL ET AL.	
	<b>Examiner</b> JOHN M. WINTER	<b>Art Unit</b> 3685	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 November 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 9, 13-16, 19 and 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 9, 13-16 and 19, and 21-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants amendment filed on November 27, 2009 is hereby acknowledged, Claims 3-5, 9, 13-16 and 19, and 21-38 are pending.

### ***Response to Arguments***

2. The Applicant states that nowhere in the combination of Gay, Rackman, Newman et al. and Kennedy is there disclosed or suggested a method or system of the pending claims. Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) “To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.”, the Examiner states the reference deals with secure electronic documentation, and therefore would be obvious to a person of ordinary skill in the art. The claimed feature of “storing the shadow document in a computer usable memory, determining and visually rendering a complete tree representing the conversation thread of electronic mail messages responsive at least in part to the shadow document,” is disclosed by Newman, and Kennedy. Paragraph 34 of Newman discloses constructing a tree table with link to sub tree tables that map an information structure; the Examiner submits that this is analogous to the claimed feature of “determining and visually rendering a complete tree”, further more Kennedy discloses the claimed feature of “wherein the visual rendering of the complete tree representing the

conversation thread of electronic mail messages graphically represents the original document as a child of the identified parent document and as a parent of the identified child document” (Figure 4b – for Example Message A is the parent and B,C etc.. are the children).

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ARTICLE 100

TITLE	MESSAGE ID	REFERENCES FIELD
MESSAGE 1	A	- NO REFERENCE - 100
MESSAGE 2	B	< A > 102
MESSAGE 3	C	< A > < B > 104
MESSAGE 4	D	< A > 106

(SIMPLE CASE)

FIG.4a

ARTICLE 200

TITLE	MESSAGE ID	REFERENCES FIELD
MESSAGE 1	A	- NO REFERENCE - 110
MESSAGE 2	B	< A > 112
MESSAGE 3	C	< A > < B > 114
MESSAGE 4	D	< A > 116
MESSAGE 5	E	< A > < D > 118
MESSAGE 6	F	< A > < D > < E > 120
MESSAGE 7	G	< D > < E > < F > 122
MESSAGE 8	H	< A > < D > < E > 124

(COMPLEX CASE)

FIG.4b

The Examiner further notes that the claimed feature “and wherein after deleting of the original document the visual rendering of the complete tree representing the conversation

thread of electronic mail messages is preserved except with a modified graphical representation of the original document, wherein the modified graphical representation of the original document within the visual rendering of the complete tree representing the conversation thread of electronic mail messages after deleting of the original document visually indicates that the original document has been deleted“ merely states the result of an action. A (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)).

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 3-5, 9, 13-16 and 19 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claims 3-5, 9, 13-16 and 19 are rejected based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject

matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 3 fails prong (1) because the “tie” (e.g. electronic messages ) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. Claims 4-5, 9, 13-16 and 19 are either dependant upon claim 3 or contain similar limitations and are rejected for at least the same reasons.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3-5, 9, 13-16 and 19, and 21-38 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 3 recites the limitation " wherein after deleting of the original document" There is insufficient antecedent basis for this limitation in the claim since action of deleting the document is not performed.

Claims 4-5, 9, 13-16 and 19, and 21-38 are either dependna upon claim 3 or contain similar limitations and are rejected for at least the same reasons.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3-5, 9, 13-16 and 19-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay, (US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646), and further in view of Newman et al (US Patent Application Publication 2004/0205535) and further in view of Kennedy (US Patent 6,330,589).

7. As per claims 3, 9, 13, 19, 21, 24,25 29,20,33, 34 and 38

Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method performed by the computer system comprising:

8. creating a shadow document from an original document, wherein the original document is an electronic mail message within a conversation thread of electronic mail messages (Figure 2 – Examiner notes “wherein the original document is... “is directed towards non functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01))

parsing the original document for selected logistical data comprising any of sender, receiver, original size, subject, or carbon copies of the original document, and storing the logistical data in the shadow document; (Column 7, line 29 – Column 8, line 10)

Gay (‘145) does not explicitly disclose identifying, within the conversation thread of electronic mail messages, a parent document and a child document of the original document, wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, and storing references thereto in the shadow document;. Rackman (‘646) discloses identifying, within the conversation thread of electronic mail messages, a parent document and a child document of the original document, wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, (Column 8, lines 47-52 – Examiner notes “wherein the original document is... “ is directed towards non functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70



USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01) and storing references thereto in the shadow document; (Column 8, lines 15-17; figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

Gay ('145) does not explicitly disclose determining and visually rendering a complete tree, Newman et al ('535) discloses determining and visually rendering a complete tree, (Paragraph 34). It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Gay ('145) method in view of Newman et al ('535) in order to create a data view that allowed for identification of discrepancies between the documents.

Gay ('145) does not explicitly disclose representing the conversation thread of electronic mail messages responsive at least in part to the shadow document ,wherein the rendering of the complete tree representing the conversation thread of electronic mail messages represents the original document as a child of the identified parent document and as a parent of the identified child document, and wherein a structure of the complete tree representing the conversation thread of electronic mail messages is preserved after deleting of the original document.

Kennedy ('589) discloses wherein the representing the conversation thread of electronic mail messages responsive at least in part to the shadow document, rendering of the complete tree representing the conversation thread of electronic mail messages (column 9,

lines 45-55) represents the original document as a child of the identified parent document and as a parent of the identified child document, (column 11, lines 48-65, Figure 4b) and wherein a structure of the complete tree representing the conversation thread of electronic mail messages is preserved after deleting of the original document.(Column 10, lines 9-39, Figure 4b, fig 7C) Examiner notes that the language “wherein the visual rendering of the complete tree representing the conversation thread of electronic mail messages graphically represents the original document as a child of the identified parent document and as a parent of the identified child document “ is directed towards non functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01), furthermore the language of “and wherein after deleting of the original document the visual rendering of the complete tree representing the conversation thread of electronic mail messages is preserved except with a modified graphical representation of the original document, wherein the modified graphical representation of the original document within the visual rendering of the complete tree representing the conversation thread of electronic mail messages after deleting of the original document visually indicates that the original document has been deleted ” is merely stating the result of an action. A (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)). It would be obvious to one

having ordinary skill in the art at the time the invention was made to modify the Gay ('145) method in view of Newman et al ('535) in order to create a data view that allowed for identification of discrepancies between the documents.-

9. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

10. As per claims 4, 22 and 31,

Gay ('145) discloses the method of claim 3 wherein "A" further comprises:  
filtering the original document for selected content.(Figure 2)

11. As per claims 5, 23 and 32,

Gay ('145) discloses the method of claim 3

Gay ('145) does not explicitly disclose wherein the shadow document further comprises selected data from the content of the original document. Rackman ('646) discloses wherein the shadow document further comprises selected data from the content of the original document. (Figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in

order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing.

12. As per claims 14, 26 and 35,

Gay ('145) discloses the method of claim 13

wherein at least one of the plurality of presented documents is an original document.(Figure 5)

13. As per claim 15, 27 and 36

Gay ('145) discloses the method of claim 13

wherein at least one of the plurality of presented documents is a shadow document.(Figure 5)

14. As per claim 16, 28 and 37,

Gay ('145) discloses the method of claim 1 further comprising:

resolving the reference in a shadow document to one of the parent and child document, and maintaining in memory data identifying a plurality of shadow documents and any parent and child documents thereof.(Figure 2)

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685